

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RICHARD D. HEIN and WALTER J. KELLY

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Appeal No. 1997-0726  
Application No. 08/329,398<sup>1</sup>

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ON BRIEF

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Before MEISTER, McQUADE, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 5, which are all of the claims pending in this application.

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<sup>1</sup> Application for patent filed October 26, 1994. According to the appellants, the application is a division of Application No. 08/158,713, filed November 24, 1993, now U.S. Patent No. 5,848,782; which was a continuation of Application No. 07/874,930, filed April 28, 1992, now abandoned.

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We REVERSE.

BACKGROUND

The appellants' invention relates to a method of assembling a fluid damped elastomer mount. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' brief.<sup>2</sup>

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Shtarkman	4,560,150	Dec. 24,
1985		
Eberhard et al. (Eberhard)	4,650,169	Mar. 17, 1987

Claims 1 through 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Shtarkman in view of Eberhard.

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<sup>2</sup> We understand the following terms from claims 1-5 as referring to the same element: a sealed fluid composite member, a sealed fluid package, said fluid package, and said fluid package member. We also understand the term "said top and said bottom diaphragm" recited in claim 5 as referring back to the "top diaphragm member" and the "bottom diaphragm member" recited in parent claim 4.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 13, mailed July 5, 1996) for the examiner's complete reasoning in support of the rejection, and to the appellants' brief (Paper No. 12, filed February 20, 1996) and reply brief (Paper No. 15, filed August 22, 1996) for the appellants' arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 through 5 under

35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

In the rejection, the examiner found (answer, pp. 2-3) that Shtarkman discloses

a method of assembling a viscously damped elastic mount having upper and lower compliance members 18, 30 forming a void which receives sealed member 34, the method comprising filling and sealing the member 34 and then placing it within the void in cooperative contact with one of the compliance member (See Fig. 2).

The claimed invention differs [from Shtarkman] only in the type of viscous material [contained within the sealed member 34].

The examiner then found that Eberhard discloses

a mount of the type claimed which utilizes a fluid as the viscous material.

The examiner then determined that

[i]t would have been obvious to one of ordinary skill in the art to have utilized a fluid in the damper of Shtarkman in view of the teaching of Eberhard et al. as a substitute of known equivalents dependent on the desired damping rate.

The appellants argue (brief, p. 5,) that the examiner's finding that the recited upper compliance member was readable on Shtarkman's inner casing wall 30 was erroneous. Specifically, the appellants assert that a compliance member must be "resilient" and that Shtarkman's inner casing wall 30 is not resilient as taught by the appellants' specification at pages 6 and 8.

The examiner responded to this argument (answer, p. 4) by stating that

the term "compliant" is not synonymous with "resilient" and appellants specification does not preclude the broader definition of compliant being yieldable. Note that the wall 30 which is made of steel. Steel, though being rigid, is yet at the same time one of the most resilient materials and has a degree of flexibility.

The appellants responded (reply brief, pp. 1-2) to this position of the examiner by stating that the examiner's characterization of steel is "unduly metaphysical" and that Shtarkman's inner casing wall 30 "cannot fairly be considered to be 'yieldable.'"

We agree with the examiner that the proper interpretation<sup>3</sup> of "compliance" as used in claim 1 is "yieldable." However, we agree with the appellants that Shtarkman's inner casing wall 30 is not disclosed as being yieldable and thus is not readable on the claimed "upper compliance member." In that regard, Shtarkman teaches (column 3, lines 23-26) that the

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<sup>3</sup> It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

inner casing wall 30 is "preferably constructed of a rigid material such as steel." In addition, as shown in Figures 1 and 2 of Shtarkman, the inner casing wall 30 is not shown to undergo any change when the spring strut is moved from its free state (Figure 1) to its compressed state (Figure 2). Thus, we conclude that Shtarkman's inner casing wall 30 is not yieldable and thus is not readable on the claimed "upper compliance member."

Since all the limitations of claims 1 through 5 have not been shown to have been obvious from the applied prior art, the decision of the examiner to reject claims 1 through 5 under 35 U.S.C. § 103 is reversed.



CONCLUSION

To summarize, the decision of the examiner to reject  
claims 1 through 5 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES M. MEISTER	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JOHN P. McQUADE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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WAYNE L. JACOBS, ESQ.,  
WOOD HERRON & EVANS, P.L.L.  
2700 CAREW TOWER  
CINCINNATI, OH 45202

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APPLICATION NO. 08/329,398

APJ NASE

APJ MEISTER

APJ McQUADE

DECISION: **REVERSED**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 17 Jun 99

**FINAL TYPED:**